

REMARKS

Claims 1, 3, 4, 7-38, 40, 41, 44-80, 82, and 84-106 are pending. Claims 38, 40, 41, 44-80, and 82 are withdrawn as being directed to a non-elected invention. Claims 1, 3, 4, 7-37, and 84-106 are rejected under 35 U.S.C. § 102(b) for anticipation by Lee et al. (U.S. Patent Application Publication No. 2003/049329 A1; hereinafter "Lee"). By this reply, Applicants cancel claims 7 and 44, amend claims 1, 37, 38, 77, 78, and 80, and address the Examiner's rejection.

Support for the Amendment

Support for the amendment to independent claims 1, 37, 38, 77, 78, and 80 is found in prior claims 7 and 44. No new matter is added by the amendment.

Rejoinder

Claims 38, 40, 41, 45-80, and 82 are withdrawn from consideration. In response to the Restriction Requirement mailed on October 16, 2007, Applicants were required to choose between four invention groups. Applicants elected the claims of Group I directed to an osteoinductive powder. Applicants have amended withdrawn claims 38, 40, 41, 45-80, and 82 during prosecution to include the same limitations as examined claims 1, 3, 4, 8-37, and 84-106. Thus, upon the allowance of claims 1, 3, 4, 8-37, and 84-106, Applicants respectfully request reconsideration of the restriction requirement and rejoinder and allowance of withdrawn claims 38, 40, 41, 45-80, and 82 (see M.P.E.P. § 821.04).

Rejection under 35 U.S.C. § 102

Claims 1, 3, 4, 7-37, and 84-106 are rejected under 35 U.S.C. § 102(b) for anticipation by Lee.

To be anticipatory, a reference must teach each and every limitation of a claim ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros.*

v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

The Office, without detailed explanation and without directing Applicants to any paragraph in Lee, states:

Lee...et al disclose an osteoinductive powder comprising a demineralized bone matrix (DBM) and a calcium phosphate powder. The percentage of demineralized bone matrix is within the claimed percentage, as is the size of the DBM particles. Biologically active agents are also included. The ratio of calcium to phosphate is also set out fibrous embodiments having the instantly claimed characteristics. The instant claims are anticipated by Lee Dosuk et al.

(Office Action, pp. 2-3.) Applicants respectfully disagree with the Office's conclusion, but in the interest of expediting prosecution of present claims 1, 3, 4, 8-37, and 84-106, Applicants have amended independent claims 1 and 37 to recite that the claimed powders include demineralized bone matrix particles having a particle size of less than about 850 μm . Lee does not teach or suggest the powders of present claims 1, 3, 4, 8-37, and 84-106; the Office has provided no evidence to the contrary.¹

The anticipation rejection of claims 1, 3, 4, 7-37, and 84-106 over Lee should be withdrawn.

¹ Applicants also concurrently submit a Petition to Withdraw Finality. Given the absence of any analysis by the Office explaining how Lee et al. anticipates claims 1, 3, 4, 7-37, and 84-106, Applicants lack a sufficient factual basis upon which to rebut the Office's novelty rejection of claims 1, 3, 4, 7-37, and 84-106 in view of Lee et al. For this reason, Applicants respectfully request withdrawal of finality of the present Office Action to allow Applicants a fair opportunity to respond to the new ground of rejection. In the alternative, Applicants request that the Office enter the claim amendments submitted in this response because it places the claims in better condition for appeal.

CONCLUSION

In view of the above remarks, Applicants respectfully submit that present claims 1, 3, 4, 8-38, 40, 41, 45-80, 82, and 84-106 are in condition for allowance, and such action is respectfully requested.

If there are any additional charges, or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

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